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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,939

06/23/2003

David Roy Pawloski

BCI-169US

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08/31/2004

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EXAMINER

GREEN, ANTHONY J

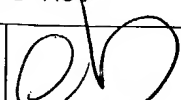
ART UNIT

PAPER NUMBER

1755

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,939	Applicant(s) PAWLOSKI, DAVID ROY	
	Examiner Anthony J. Green	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 13 and 40 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/08/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

It is not seen as to where, in the specification, the support lies for all of the amounts recited in claims 11-14 and 38-40 and the for temperature ranges found in claims 19 and 21.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 27, 31 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassens, Jr (US Patent No. 3,879,208).

The reference teaches, in the examples and the claims a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the

future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6411. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

4. Claims 1, 4, 6, 11, 27, 31, 33, 38, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. JP02-197836.

The reference teaches, in the abstract, a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6412. As for the amounts, it appears that the instantly claimed amounts are encompassed by the amounts recited in the reference. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 05-127323.

The reference teaches, in the abstract, a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is

for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6413. Accordingly since the reference teaches a composition that encompasses that which is instantly claimed it anticipates the instant claims.

6. Claims 1, 4, 27, 31 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 06-194791.

The reference teaches, in the abstract, a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6414. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chinese Patent Specification No. 1153593.

The reference teaches, in the abstract, a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a

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composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6415. Accordingly since the reference teaches a composition that encompasses that which is instantly claimed it anticipates the instant claims.

8. Claims 1, 2, 4, 27, 29, 31 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by over Dieso (US Patent No. 6,695,901).

The reference teaches, in the claims, and the examples, an aqueous gypsum dental casting composition comprising water; gypsum; a first compound selected from magnesium sulfate, aluminum sulfate etc.; a second composition selected from an alkali metal sulfate, metaborate, tetraborate; and two or more acids such as oxalic acid, boric acid, citric acid etc. See the examples especially examples example 10 and 37 and claim 12. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6416. Accordingly since the reference teaches a composition and a method of making a composition that encompasses that which is instantly claimed it anticipates the instant claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-170368.

The reference teaches, in the abstract, a refractory material comprising high alumina raw material aggregate, silica powder, aluminum sulfate, refractory clay and at least one of oxalic acid, citric acid and borax as a setting regulator.

The instant claims are obvious over the reference. While the reference does not specifically teach the instant composition it does suggest the formation of a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6417. Accordingly based on the teachings of the reference the instant claims are rendered obvious.

11. Claims 1, 4, 27, 31 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Patent No. 4,401,526).

The reference teaches, in the examples and the claims, an aqueous zinc alloy plating bath comprising various additives. According to column 3, lines 14+, various additional additives or agents may be added which include aluminum sulfate, citric acid, boric acid etc. and that the pH can be adjusted to from 0 to about 8.9 depending on the bath utilized.

The instant claims are obvious over the reference. While the reference does not specifically teach the instant composition it does suggest the formation of a composition that encompasses that which is instantly claimed. While the reference does not teach that the composition is for treating the surface of a ferrous metal it should be noted that the future use of a composition adds little or no patentable weight to a claim when the composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 6418. Accordingly based on the teachings of the reference the instant claims are rendered obvious.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-12, 14-39 and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims it is unclear as to the types of polycarboxylic acids encompassed by the claim. Claims in which one component is defined so broadly that it

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reads on a second, fail to meet the requirements of the second paragraph of 35 USC 112. See *Ex parte Ferm et al* 162 USPQ. Note that some of the claims that are dependent on the independent claims recite that the composition further comprises various acids that are encompassed by the term polycarboxylic acids and therefore it is unclear as to whether or not the recited acids are in addition to the polycarboxylic acid recited in the independent claims (i.e. a second polycarboxylic acid) or if they are examples of the type of polycarboxylic acid that are useable. See dependent claims 9-10, 12, 22-23, 25, 36-37, 39 which recite various examples of polycarboxylic acids which appear to encompass the polycarboxylic acids recited in the claims from which they depend.

Allowable Subject Matter

14. Claims 13 and 40 would be allowable upon correction of the lack of antecedent basis for the claimed subject matter. See Item #1 above.

15. Claims 3, 5, 7-10, 12, 14-26, 28, 30, and 32-40 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and provided that the lack of antecedent basis problem is corrected if it applies to the particular claims in question (see Item #1 above).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
August 27, 2004